

REMARKS

Applicant has amended the application to reflect the issuance of the parent application of the present invention, as requested in Paragraph 1 of the Office Action. Review, reconsideration and allowance of claims 1-17 are respectfully requested.

The present invention concerns a gift package for holding a product, such as a flashlight or a medallion, in a tray within an outer package having a decorative flap such that the product can be given as a gift. The gift product is held in a tray that slides into the outer package body. The tray is pushed into the outer package body through one of two oppositely located side openings. The side openings are not associated with the hinged outer flap that covers the outer package when in a default first position. The tray is maintained within the outer packaging by friction. The outer package comprises a window or opening such that the product can be seen when the flap is in a second, open, position. As claimed, the outer flap is in contact relationship with the body of the package in the first default position and requires no locking means (such as a tab or Velcro®) to keep the top in contact relationship with the body of the package. The outer flap is not used in the present invention to hold the gift product within the package body.

The Office Action has rejected claims 1, 2, 4-8 and 10-16 under 35 U.S.C. Section 103(a) as being unpatentable over Sylvester (U.S. Patent No. 5,794,631) in view of Stearns (U.S. Patent No. 5,469,965) or Saye (U.S. Patent No. 5,575,384). The Office Action notes that Sylvester discloses a number of parts, which the Office Action delineates, including “a holder (31)”. Applicant respectfully submits that item 31 of the Sylvester patent is not a “holder” but is instead a cassette; that is either a video cassette or an audio cassette that is the product that is being sold or stored in the package of Sylvester. The cassette of Sylvester is the product and not a holder.

As such, Sylvester does not teach the present invention. The inclusion of the tray in the present invention is instrumental in the overall appearance of the gift package, placing the product in an elegant display. Sylvester does not disclose a tray because the actual product, a cassette, is held within the packaging without the use of a tray or holder of any kind. Further, Sylvester requires the use of locking means (40) to hold the outer lid of the package against the main body of the packaging. The cassette of Sylvester is shown to be removable from the packaging *through the opening that is covered by the flap of the box attached to the locking means*, the locking means thereby actually serving to close the open main body of the packaging – forming a wall such that the cassette cannot fall therefrom. In sharp contrast, the outer flap of the present invention covers the main body of the package but the product is removed by pushing the tray from a secondary opening not directly covered by the flap. The flap in the present invention is not part of the packaging holding the product, as is the case with all of the art cited by the office action. As presently claimed, including the limitation that there is contact in the default position and that the package has no locking means, the present invention is distinct from all of the cited references. All of the other cited references require some sort of locking means to keep the product within the package.

With respect to Stearns and Saye, neither reference adds teachings which would make the present invention obvious in view of Sylvester. The teaching in Stearns and Saye of a tray would not have made the present invention obvious as there is no need to add a tray to the teaching of Sylvester as the product (31) being placed in the packaging of Sylvester fits within the entire cavity (30) provided to hold the product. Further, rigidity provided by a tray is unnecessary as a cassette tape inherently provides rigidity. No person having skill in the art would consider using a tray, as shown in Stearns and Saye, to provide rigidity in Sylvester where the cassette by itself

provides all the rigidity needed. Adding extraneous trays to packaging adds to the cost of the packaging and adds weight which increases the costs of shipping such packages. Accordingly persons having skill in the art would be more inclined to remove elements of packaging rather than adding elements.

Regarding arguments concerning claim 6 and 7, since the underlying disclosure is not taught by the combination of the cited references, the inclusion of a cut-out or a window in Sylvester would not make the present invention obvious. With respect to the argument concerning claim 13, Sylvester does not teach a tray; the package of Sylvester directly holds the object (a cassette tape). The cassette tape could not be modified to hold a flashlight or medallion as such would be a nonsensical result.

The Office Action has rejected claims 3, 9, 12 and 17 under 35 U.S.C. Section 103(a) as being unpatentable, as above, and in view of Heuer et al. (U.S. Patent No. 4,739,353) or Applebaum et al. (U.S. Patent No. 5,409,105). These references add nothing further to Sylvester to make the present invention obvious. Sylvester, as explained above does not include a tray and the “flap” of Sylvester is used, along with locking means, to keep the item held by Sylvester in place. In sharp contrast, and as noted above, as presently claimed the device of the present invention needs no locking means as the product carried is not held in place by the flap.

Applicant encloses herewith a terminal disclaimer to obviate the non-statutory double patenting rejection. A check to cover the fee for the terminal disclaimer is also enclosed herewith. If the enclosed fee is insufficient, or if it is determined that a further fee and/or a petition is required, the Commissioner is hereby authorized to charge any such fee to deposit account number 23-0920 and it is respectfully requested that this paper be considered as the required, or necessary, petition.

Applicant respectfully requests that should the Examiner be of the opinion that an inadvertent error was made in Office Action's in the interpretation of the Sylvester (U.S. Patent No. 5,794,631) reference, specifically in the above noted confusion with respect to the **cassette** 31 (called "**holder**" in the Office Action) that the Examiner, should further art be found, provide Applicant with another *non-final* rejection. Applicant hereby respectfully requests reconsideration and continued examination. A sincere effort has been made to overcome the Action's rejections and to place the application in allowable condition. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to telephone applicant's undersigned attorney.

In view of the foregoing remarks and amendments, it is believed that the subject application is now in condition for allowance, and an early Notice of Allowance is respectfully requested.

Respectfully submitted,



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